

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
NORTON SPIEL)
Application No.: 10/828,988)
Filed: April 21, 2004)
For:)
COMBINATION PLASTIC SPIRAL)
FORMING MACHINE AND SEMI-)
AUTOMATIC PLASTIC SPIRAL)
BINDING MACHINE)

Atty. Dkt. No.:
SPIEL COMBO-CON 2
Examiner: Cadugan; Erica E.
Art Unit 3722

FAX RECEIVED

AUG - 1 2008

Hon. Commissioner of Patents
Mail Stop RCE
PO Box 1450
Alexandria VA 22313-1450

PETITION TO WITHDRAW APPLICATION FROM ISSUANCE AFTER NOTICE OF
ALLOWANCE AND PETITION TO FILE INFORMATION DISCLOSURE
STATEMENT UNDER 37 C.F.R. 1.97 and 1.98

Dear Sir:

In connection with the attached Request For Continued Examination (RCE), Applicant submits this Petition to withdraw the above identified application from issuance after Notice of Allowance and petitions to submit a further Information Disclosure Statement to have the Examiner consider a reference pursuant to 37 C.F.R. 1.97 and 1.98.

Applicant therefore submits the attached two page reference of Sickinger Company, entitled "Pure Plastic Coil Binder" regarding a "PW-517" machine. In order for this reference of Sickinger Company to be considered, Applicant submits the attached Request For Continued Examination and Information Disclosure Statement by Applicant.

Please deduct any deficiencies in fees (small entity) from Applicant's attorney's deposit account number 23-0120.

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REMARKS

Since Applicant submits a newly cited reference of Sickinger Company entitled "Pure Plastic Coil Binder" regarding a "PW-517" machine, Applicant withdraws the application from issuance after the Notice of Allowance and requests that all claims be reviewed in view of the Sickinger Company brochure.

In order to have the claims considered over the Sickinger Company reference, Applicant submits the attached Request for Continued Examination (RCE) and submits the fee of \$405. Please deduct the fee (or any deficiencies thereof) from Applicant's attorney's deposit account 23-0120.

The need to submit the Sickinger Company reference for consideration was brought to Applicant's attorney's attention by a letter of July 23, 2008. Upon review of the Information Disclosure Statement of March 9, 2006, it appears that the Sickinger Company reference is not of record.

The reference was brought to our attention by the defendant's attorney in the law suit already of record in this matter and the attorney asserted we needed to send an actual copy of the document in to satisfy the disclosure rules, in view of the examiner's comments in the reasons for allowance. Although we disagree, since the reference was thoroughly discussed in the documents that were filed, we nevertheless want to avoid any issues going forward. Thus, we want the Sickinger brochure itself formally considered by the examiner.

Since this reference, although it is referred to as an Exhibit to the report of Walter Klassen already of record, is not yet of record and the Notice of Allowance was previously mailed, Applicant submits the \$130 petition fee is believed to be due under 37 CFR 1.97 and 37 CFR 1.98.

This two page reference of Sickinger Company is an exhibit to a previously cited reference already of record in this patent application, namely, of the expert witness report of Walter Klassen dated November 23, 2004 in the litigation of Spiel Associates, Inc. v. Gateway Bookbinding Systems, Ltd., Index Number 03 CV 4696 in the United States District Court for the Eastern District of New York.

The Sickinger reference would have been merely cumulative to everything else of

record but becomes material now because the Examiner made the mistaken conclusion that "heating then forming" was one of the distinguishing features of independent Claim 31, which it is not.

The Sickinger reference does not mention that, upon information and belief, the device also internally cools the coils before inserting them into the respective holes of the assembled pages of a book being bound by a coil.

The Sickinger brochure about the PW 517 machine discloses exactly what Walter Klassen previously stated on page 17 of his expert report, namely that *"the PW517 forms the plastic filament into coils after it passes through a heated cabinet."*

The Sickinger brochure about the PW 517 machine is also discussed in the rebuttal expert report of Pierre Primeau, also of record in this application, wherein Mr. Primeau states *"I know the Sickinger machine very well, as I still have two of them. We have used the Sickinger machine in the past and we stopped struggling with it because the quality of the final product was not always there and the productivity was very bad. The machine is very different from the Gateway and Spiel machines. The Sickinger machine was inserting an on-demand coil into a book in one continuous process."*

In presumably discussing US Patent 4,249,278 of Pfaffle, already of record, Mr. Primeau further refers to Mr. Klassen's statements and states:

Walter Klassen is saying "The process is not the tightly coupled process listed in the patent." As you can see on the Sickinger brochure, the device that is a few inches beside is the pre-heating unit. The forming, cooling, inserting and crimping is all in one process."

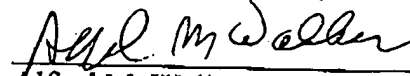
This Petition and Information Disclosure Statement is timely, as the issue fee has been previously paid, and is being submitted with the attached Request for Continued Examination (RCE).

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Please withdraw the above application from issuance so that the reference can be considered. It is respectfully submitted that, after consideration of the reference, the case in allowable form, which allowance is earnestly solicited.

Date: August 1, 2008

Respectfully submitted,

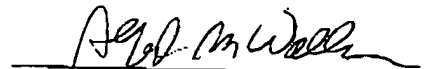


Alfred M. Walker
Attorney for Applicant
Reg. No. 29,983
225 Old Country Road
Melville, New York 11747
(631) 361-8737

CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this correspondence is being deposited by fax to 571-273-8300 on the date indicated below.

Date: August 1, 2008


Alfred M. Walker

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SUPPLEMENTAL PETITION TO WITHDRAW APPLICATION FROM ISSUANCE

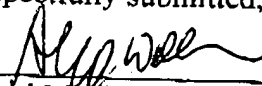
Dear Sir:

In connection with the Petition filed on August 1, 2008 to withdraw the above identified application from issue, Applicant requests that the petition be fast tracked, since the issue fee was paid on July 14, 2008 and the application was considered ready for issue on July 18, 2008.

Applicant's attorney also notes that the certificate of fax transmission states that the petition was sent to the general fax number 571-273-8300, but in fact it was actually sent to the Petitions Branch at 571-273-0025, as noted on the attached fax transmission report.

Date: August 4, 2008

Respectfully submitted,



Alfred M. Walker
Attorney for Applicant
Reg. No. 29,983
225 Old Country Road
Melville, New York 11747
(631) 361-8737

CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this correspondence is being deposited by fax to 571-273-0025 on the date indicated below.

Date: August 4, 2008


Alfred M. Walker